

Application No.: 09/516,090  
Attorney Docket No. 99-003

REMARKS

By this Amendment, Applicant rewrites claims 23 and 24 in independent form and cancels claim 18 and 22 without prejudice or disclaimer of the subject matter thereof. Claims 1-17, 19-21, and 23-30 remain pending in this application.

In the Office Action, the Examiner indicated that claim 18 will be objected to as being a substantial duplicate of claim 15, should claim 15 be allowed. In addition, the Examiner objected to claim 22 as being a substantial duplicate of allowed claim 19. To expedite prosecution, Applicant has canceled claims 18 and 22 without prejudice or disclaimer. Accordingly, the Examiner should withdraw the objection.

The Examiner rejected claims 15, 18, 28, and 30 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which Applicant regards as the invention; rejected claims 1, 2, 4, 9, 10, 13, 14, 29, and 30 under 35 U.S.C. § 103(a) as unpatentable over Ho et al. (U.S. Patent No. 6,408,181) in view of Forslow (U.S. Patent Application Publication No. 2003/0039237); and rejected claims 3, 5-8, 11, 12, 15-18, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Ho in view of Wang (U.S. Patent No. 6,526,033), and further in view of Forslow.

The Examiner also allowed claims 19-21 and 25-27. Applicant thanks the Examiner for the indication of allowable subject matter. In addition, the Examiner objected to claims 23 and 24 as dependent upon a rejected base claim, but indicated that these claims would be allowable if rewritten in independent form including all of the recitations of each claim's base claim and any intervening claims. By this Amendment, Applicant has rewritten claims 23 and 24 in independent form to each include the recitations of claim 22. Accordingly, the Examiner should allow claims 23 and 24.

Application No.: 09/516,090  
Attorney Docket No. 99-003

Applicant respectfully traverses the rejection of claims 15, 18, 28, and 30 under 35 U.S.C. § 112, second paragraph, as being indefinite. In the Office Action, the Examiner has not offered any reason why the claims are believed to be indefinite. See Office Action, page 3.

The MPEP explains that the test for indefiniteness is whether "the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." See MPEP §2173 at § 2173.02 ("Clarity and Precision"), 8<sup>th</sup> Edition, Revision 2, May 2004. Moreover, the MPEP requires "the examiner [to] consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph." *Id.* "If the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more." *S3, Inc. v. Nvidia Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001), quoting *Miles Laboratories, Inc. v. Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993).

Claim 18 has been canceled without prejudice or disclaimer, and the rejection with regard to it is thus moot. Claims 15 and 30 recite methods "for communicating data from a wireline terminal to a mobile terminal in a telecommunications network." Claim 28 recites a network comprising, among other things, "a home node," a visited node, and "a server." One of ordinary skill in the art would be able to readily understand the scope of these claims. The definiteness requirement of 35 U.S.C. § 112, second paragraph, is thus met, and Applicant respectfully requests the Examiner to withdraw the rejection.

Application No.: 09/516,090  
Attorney Docket No. 99-003

Applicant traverses the rejection of claims 1, 2, 4, 9, 10, 13, 14, 29, and 30 under 35 U.S.C. § 103(a) as unpatentable over Ho in view of Forslow. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must meet each of the following three requirements. First, the reference taken alone, or references combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8<sup>th</sup> ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8<sup>th</sup> ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8<sup>th</sup> ed. 2001). Moreover, each of these requirements must be found in the prior art, and not be based on applicant's disclosure. See M.P.E.P. § 2143 (8<sup>th</sup> ed. 2001).

Claim 1 recites a combination including, among other things, "receiving by a server data destined for the mobile terminal," "preassigning a plurality of Internet Protocol (IP) addresses to the server; and configuring the server to associate one of the preassigned IP addresses with the mobile terminal." Ho and Forslow do not teach or suggest at least these features.

Regarding the claimed "server," the Examiner alleges that a "server is considered here to be an inherent component of a data processing system that handles databases." See Office Action, page 4. To establish inherency, the Examiner must specifically identify extrinsic evidence that makes clear to one skilled in the art that the missing element "is necessarily present" in Ho. See *id.*; see also Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991). However, the Examiner has not

Application No.: 09/516,090  
Attorney Docket No. 99-003

offered any evidence other an assertion that any data processing system must inherently include servers. Applicant respectfully disagrees and requests the withdrawal of the rejection of claim 1 for at least this reason.

In addition, regarding the claimed "preassigning a plurality of Internet Protocol (IP) addresses to the server; and configuring the server to associate one of the preassigned IP addresses with the mobile terminal," the Examiner alleges Forslow teaches these features, citing paragraphs 0051 and 0104. Applicant respectfully disagrees.

The Forslow system discloses performing a host configuration operation to establish a network layer (IP) bearer communication between a mobile host and an external network entity like an ISP. To do so, the IP configuration includes assigning a network layer (IP) address to a **mobile station**. See paragraph 0051. However, this teaching does not disclose or suggest "preassigning a plurality of Internet Protocol (IP) addresses to the server," as recited in claim 1. Accordingly, the rejection of claim 1 is improper for at least this additional reason.

Moreover, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. The Examiner merely alleges Ho and Forslow are combinable because they both share the common endeavor of mobile telecommunications. See Office Action, page 5. Applicant respectfully disagrees. Ho is directed to increasing network capacity in a GSM networks by reducing the number of home location register and visitor location queries. See col. 1, lines 8-17. On the other hand, Forslow discloses that a significant

Application No.: 09/516,090  
Attorney Docket No. 99-003

advantage of its system is that applications running on a mobile station or on an external network entity such as an ISP may specify an individual application flow based on a quality of service and select a bearer for use when transferring the application flow through the network. See paragraph 27. Forslow thus teaches selecting transfer mechanisms based on quality of service parameters for an individual application. See paragraph 32. Therefore, even if Forslow made up for the shortcomings of Ho, which Applicant disputes for the reasons discussed above, one of ordinary skill in the art would not be motivated to combine the application-specific system of Forslow with the scheme of Ho for reducing the number of home location register and visitor location queries. Finally, the Examiner has not provided a reasonable expectation of success for making the proposed combination. Accordingly, the Examiner should withdraw the rejection of claim 1 for at least these additional reasons.

Claims 29 and 30, while of a different scope, include similar features as allowable claim 1. Applicant respectfully requests that the Examiner allow claims 29 and 30 for at least the same reasons as discussed above regarding allowable claim 1.

In addition, claims 2, 4, 9, 10, 13, and 14 depend from allowable claim 1 and are allowable for at least the same reasons as discussed above. Applicant respectfully requests that the Examiner withdraw the rejection and allow these dependent claims.

Applicant respectfully traverses the rejection of claims 3, 5-8, 11, 12, 15-17, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Ho in view of Wang, and further in view of Forslow.

Claim 15 includes recitations of a scope similar to that of claim 1. For example, claim 15 recites a combination including, among other things, "sending the data packets

Application No.: 09/516,090  
Attorney Docket No. 99-003

to a server for communicating the data packets to the mobile terminal on a connection initiated by the server such that the connection is established via a route that excludes a home node associated with the mobile terminal when the mobile terminal resides outside of a geographical area served by the home node," "preassigning a plurality of Internet Protocol (IP) addresses to the server; and configuring the server to associate one of the preassigned IP addresses with the mobile terminal."

As discussed above, Ho and Forslow do not disclose or suggest at least these features. Wang, which is directed to delivering calls to GSM subscribers roaming to CDMA networks, does not cure the deficiencies of Ho and Forslow. Accordingly, the Examiner should withdraw the rejection of claim 15.

Moreover, there is no suggestion or motivation to combine the references in the manner suggested by the Examiner. See Office Action, pages 10-11, 13, and 14. Applicant respectfully points out to the Examiner it "is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." See In re Wesslau, 147 U.S.P.Q. 391 (C.C.P.A. 1965). See also M.P.E.P. § 2141.02, p. 2100-120. By contrast, the required motivation to combine references must "be found in the prior art, and not based on applicant's disclosure." See M.P.E.P. § 2143 (emphasis added).

In that regard, the present invention, as recited in claim 15, cannot be attained based merely on the combination of Ho, Forslow, and Wang. One skilled in the art would only arrive at the present claimed invention by consulting Applicant's disclosure

Application No.: 09/516,090  
Attorney Docket No. 99-003

to rely on aspects related to the present invention. Such reliance, however, would constitute improper hindsight reasoning. Thus, Applicant submits that Ho, Forslow, and Wang, taken alone or in combination, do not suggest the desirability of any modification to result in Applicant's claimed invention, and do not demonstrate that there would be any reasonable expectation of success from so doing.

Dependent claims 16-17 depend from allowable claim 15 and are allowable at least for the reasons discussed above. Further, dependent claims 3, 5-8, 11, and 12 depend from allowable claim 1 and are allowable for at least the same reasons as discussed above. Applicant respectfully requests that the Examiner withdraw the rejection of these dependent claims.

Claim 28, while of a different scope, includes recitations similar to that of claim 15. Applicant respectfully requests that the Examiner allow claim 28 for at least the same reasons as discussed above in connection with allowable claim 15.

Additionally, Applicant respectfully traverses the Examiner's taking of Official Notice with regard to claims 3, 8, 11, and 12. See Office Action, pages 13 and 15. Applicant refers the Examiner to the February 21, 2002 Memorandum from USPTO Deputy Commissioner for Patent Examination Policy, Stephen G. Kunin, regarding "Procedures for Relying on Facts Which are Not of Record as Common Knowledge or for Taking Official Notice." In relevant part, the Memorandum states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding" (Memorandum, p. 3).

Application No.: 09/516,090  
Attorney Docket No. 99-003

Applicant submits that the Examiner has made generalized statements regarding claims 3, 8, 11, and 12 without offering any documentary evidence to support these statements. Applicant notes the impropriety of this action, as the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." *Id.* at 1. Applicant submits that "[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is " basic knowledge" or "common sense." "*In re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejections after considering the arguments presented herein, Applicant submits that the Examiner must provide either "the explicit basis on which the examiner regards the matter as subject to Official Notice and allow Applicant to challenge the assertions in the next reply after the Office Action in which the common knowledge statement was made" (*Id.* at 3, emphasis in original), or else withdraw the rejection.

### CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 07-2339.

Respectfully submitted,

By: \_\_\_\_\_

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Dated: October 7, 2004